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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,616	02/21/2002	Andreas Wieck	101769-141/tesa AG 1527-C	9569
7590 06/24/2004 Christa Hildebrand Norris, McLaughlin & Marcus P.A. 30th Floor 220 East 42nd Street New York, NY 10017			EXAMINER EGAN, BRIAN P	
			ART UNIT 1772	PAPER NUMBER
DATE MAILED: 06/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary

Application No.

10/081,616

Applicant(s)

WIECK ET AL.

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-17 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION***Specification***

1. The specification remains objected to for failure to provide subject headings before each section. Despite the Applicant's contention that the MPEP only suggests the use of subject headings and does not require them, 37 CFR 1.77(c) states that "the text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type. The phrase "should be" is not optional language and does not infer that subject headings may or may not be used upon the Applicant's discretion. The Examiner further directs the Applicant's attention to MPEP section 608.01(a). The Examiner strongly suggests that the Applicant use subject headings throughout the specification.

Claim Interpretation

2. With regards to Applicant's newly added limitations in claims 1 and 2, the Examiner notes that the limitation "via a kiss-cut process" is directed at the method of forming the article rather than the article itself. The method of forming the device is not germane to the issue of patentability of the article itself. Therefore, this limitation has not been given patentable weight. With regard to the limitation "or changes in the electrical conductivity of the backing sheet," the Examiner notes that the limitation is in alternative form via the use of "or." Therefore, a prior art reference need only teach that the punching tool avoids abrasion or the backing sheet avoids changes in the electrical conductivity – both limitations need not be anticipated or fairly suggested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 8, 10-11, and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Greuse et al. (#5,250,336).

Greuse et al. disclose a protective material with punched shaped parts (Figs. 3-4) as well as a method of using the protective material (see Abstract) wherein a double sided adhesive tape is placed on top of the protective material (Fig. 1, #14) from which punch shaped parts are punched out by a kiss-cut punching tool (“die-cut” – Col. 4, lines 18-19), wherein the protective material comprises a colored polymer backing sheet having a top and a bottom face (note that the Examiner has defined the combination of layers #16 and #18 (the backing layer and release layer) as the polymer backing sheet – see Fig. 1). The backing sheet comprises a backing layer which itself may comprise colorants (Col. 7, lines 52-56) and further comprises an anti-adhesive dyed silicone layer along the top face of the backing sheet (Fig. 1, #16; Col. 3, lines 59-62; Col. 4, lines 1-2; Col. 7, line 64 to Col. 8, line 4) that is in contrast with the color of the backing layer (Col. 7, lines 56-62), the anti-adhesive coating being positioned on the same side of the backing layer as the adhesive tape (see Fig. 1). The color layer is applied over the full area of the backing layer (see Fig. 1; Col. 4, line 49-56).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-7, 9, 12, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greuse et al. (#5,250,336) in view of Higgins (#5,932,352).

Greuse et al. teach a protective material as detailed above. Although Greuse et al. fail to explicitly teach a coating density between 5 and 7 grams per square meter, Greuse et al. teach that the coating density may be modified depending on the desired color of the end product (Col. 5, lines 7-24; Col. 5, lines 31-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the dyed silicone layer such that it fell within the Applicant's claimed range in order to attain a desired color for the end product. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the silicone release layer such that it falls within the Applicant's claimed range, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Although Greuse et al. teach the use of a backing layer, Greuse et al. fail to explicitly teach that the backing layer is one of polyester, polystyrene, polyamide, or polyimide and also fail to explicitly teach the thickness of the backing layer.

Higgins, however, teach the use of a polymer backing sheet for a release film wherein the backing sheet may be formed from polyester (Col. 2, lines 16-18). The backing sheet, depending on the intended application, may range in thickness from 5 to 350 micrometers (Col. 8, lines 43-48). Higgins teaches the use of a polyester polymeric backing sheet in a release liner for the purpose of providing a substrate with improved processability and improved suppression of silicone debris production (Col. 1, lines 35-56). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Greuse et al. and Higgins since each of the aforementioned references are analogous insofar as being directed at silicone release liners and are both concerned with minimizing silicone debris production.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Greuse et al. to include a polyester backing sheet as taught by Higgins in order to provide a substrate with improved processability and improved suppression of silicone debris production.

Response to Arguments

7. Applicant's arguments filed April 6, 2004 have been fully considered but they are not persuasive.

The Applicant's primary contention is that Gruese et al. ('336) fail to anticipate the newly added limitations of claims 1-2. As noted above, the first limitation directed at the "kiss-cut process" is given no patentable weight in an article claim. Even if given weight, the Applicant has provided no distinction between kiss cutting and die cutting and it is posited that a disclosure of a die cutting process encompasses kiss cutting, i.e.,

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Gruese et al.'s broad disclosure of die cutting encompasses kiss cutting. Observation of Fig. 3 in Gruese et al. clearly shows a kiss cut embodiment. The Examiner further directs the Applicant's attention to the definition of kiss-cutting provided by the *Cynergy Glossary of Terms* ("Kiss-cut: A die-cutting process utilizing a metal die to cut irregular shapes out of the adhesive of a decal, but not the backing."). The second limitation "or changes in the electrical conductivity of the backing sheet" is provided in alternative form as discussed above and is also regarded as a functional limitation. The limitation need not be anticipated or fairly suggested by a prior art reference in order for the claim to be rendered unpatentable. The claimed limitation is primarily directed at the coloring being obtained by means of colorants in the interior of the backing sheet – insofar as a prior art reference teaches the use of colorants in the backing sheet, it is implicit that abrasion is avoided on the punching tool and/or changes in the electrical conductivity in the backing sheet is avoided. The functional result of placing the colorants in the backing layer (i.e., avoiding abrasion or avoiding changes in the electrical conductivity) are given little to no patentable weight unless expressed in accordance with 35 U.S.C. 112, 6th paragraph, i.e., means-plus-function phraseology. Regardless, the Examiner maintains that at the very least, the teachings of Gruese et al. anticipate a colorant in the backing sheet and thus avoid abrasion on the punching tool.

With regards to the 35 U.S.C. 103(a) rejection over Gruese et al. and Higgins, the Applicant's primary contention is that there is no evidentiary support for the motivation to combine references, i.e., the minimizing of silicone debris. The Examiner respectfully disagrees and directs the Applicant's attention to Col. 1, lines 35-42 and 54-56 of Higgins which explicitly details the problem of silicone debris in the prior art and teaches the

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invention to overcome the deficiencies caused by silicone debris. Therefore, there is sufficient evidentiary support in Higgins to support the combination of references provided for in the previous office action.

Finally, the Applicant contends that the limitations of claims 9, 16, and 17 were not addressed in the previous office action. The Examiner respectfully disagrees. The aforementioned claims are directed at the coating density of the color layer. As detailed in the previous office action:

Although Greuse et al. fail to explicitly teach a coating density between 5 and 7 grams per square meter, Gruese et al. teach that the coating density may be modified depending on the desired color of the end product (Col. 5, lines 7-24; Col. 5, lines 31-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the dyed silicone layer such that it fell within the Applicant's claimed range in order to attain a desired color for the end product. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the silicone release layer such that it falls within the Applicant's claimed range, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Therefore, the aforementioned claims were addressed in the previous office action.

Absent demonstration of any unexpected results by the Applicant, the Examiner maintains the rejection from the previous office action.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

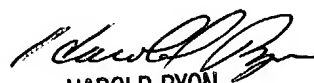
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 571-272-1491. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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6/20/04


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SUPERVISORY PATENT EXAMINER
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